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ART UNIT	PAPER NUMBER
2624	

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Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/837,193	ADACHI, MASAHITO
	Examiner	Art Unit	
	Peter K. Huntsinger	2624	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>05 July 2005</u>.

2a) ☒ This action is **FINAL.**   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-22</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-22</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1.   The amendment filled on 05 July 2005 has been entered in full.

2.   Based on the applicant's amendment, the objections to claims 21 and 22 have

been withdrawn.

Response to Arguments

3.   Applicant's arguments filed 05 July 2005 have been fully considered but they are

not persuasive.

Applicant argues, on pages 8 and 9 of the remarks, that:

Gacek does not provide a notification of the amount of data printed but

rather focuses on the number of pages that have been printed.

a.   A page of information is an amount of data. Therefore, the amount of

pages printed would indicate an amount of data printed.

Gacek does not allow for calculation of specific amounts of data and the

resulting specific amounts of ink and paper used.

b.   A page of information is a specific amount of data. In response to

applicant's argument that the references fail to show certain features of

applicant's invention, it is noted that the features upon which applicant relies (i.e.,

a calculation based on the specific amount of ink and paper used) are not recited

in the rejected claim(s). Although the claims are interpreted in light of the

specification, limitations from the specification are not read into the claims. See

In re Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The server of Gacek performs the calculation, not the printer.

c.   Yeung et al. was combined to teach the calculation occurring with the

printer. In response to applicant's arguments against the references individually,

one cannot show nonobviousness by attacking references individually where the

rejections are based on combinations of references. See *In re Keller*, 642

F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231

USPQ 375 (Fed. Cir. 1986).

Yeung et al. do not teach an amount of data.

d.   A page of information is an amount of data. Therefore, the amount of

pages printed would indicate an amount of data printed.

It is not obvious to combine a set top box with the functionality of a printer.

e.   As priory stated, While the Set Top Box as disclosed by Yeung et al. is

located physically separate from the printer, it would have been obvious to

incorporate the printer into the Set Top Box. The motivation for doing so would

have been to combine the functions of the Set Top Box and printer into one

device that would take up less space and be more functional. To support the

examiner's previous statement, the reference Mann et al. US Patent 6,652,174 is

citied to demonstrate the obviousness of combining a set top box with the

functionality of a printer.

Gacek's teaching of printing new information is not the same as printing updated information.

f.   The applicant argues that the new print request could be the same print as

was previously printed from a different provider and would not be considered

updated. However, the printing information is considered updated whenever it is

rewritten onto memory. Whether this is unique or identical data from what was

previously stored, the data is considered updated.

Kolls does not notifying a server an amount of information.

g.   Yeung et al. was combined to teach notifying a server an amount of

information. In response to applicant's arguments against the references

individually, one cannot show nonobviousness by attacking references

individually where the rejections are based on combinations of references. See

In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800

F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

4.   Claims 1-3, 8-10, 13, 14,18, 21 and 22 are rejected under 35 U.S.C. 103(a) as

being unpatentable by Gacek U.S. Patent 6,795,205 and Yeung et al. U.S. Patent

6,690,481.

Referring to claim 1, Gacek discloses an information providing system

comprising: a printer (printer 324 of Fig. 3); a user terminal (STB 322 of Fig. 3)

connected to said printer and sending print information to said printer (col.15, lines 53-

62); and an information providing server delivering information via a communication line

(3rd party merchant, col. 9, lines 28-32), wherein said printer comprises: means for

acquiring the information delivered from said information providing server, said means

for acquiring the information being connected to said information providing server via

the communication line (STB 322 of Fig. 3, col. 9, lines 49-53); means for printing the

acquired information according to a print instruction received from said user terminal

(col. 15, lines 58-62), wherein said user terminal comprises: means for sending a print

instruction to said printer (col.15, lines 58-62); and means for setting a print format of

the information (col.8, lines 52-58), which is acquired from said information providing

server (col. 15, lines 27-33), in said printer, and wherein said information providing

server comprises: means for calculating a total of the amount of information (col. 13,

lines 6-16). Gacek does not disclose expressly the printer notifying an amount acquired

and printed from the server or basing the calculation off the amount notified by the

printer. Yeung et al. disclose means for notifying an amount of information acquired

from said information providing server and printed (col. 12, lines 39-56). Gacek

discloses that the print format of the information is set from the preference directory

within CHE 6. While the method of obtaining the preferences is not given, Gacek

discloses that the user provides these preferences to the CHE 6 (col. 13, lines 46-51),

but not how this information is obtained. It would be well known and obvious for the

user to enter this information through the Set Top Box. The suggestion for doing so

would have been to provide an easy way to provide the user preferences without the

requirement of using a phone or mail service. While the Set Top Box as disclosed by

Yeung et al. is located physically separate from the printer, it would have been obvious

to incorporate the printer into the Set Top Box. The motivation for doing so would have

been to combine the functions of the Set Top Box and printer into one device that would

take up less space and be more functional. The calculation disclosed by Gacek does

not disclose expressly calculating the amount of data indicated by the printer. It would

have been obvious for the calculation to include the amount of data acquired and

printed as indicated by the printer instead of the amount sent from the server. The

motivation for doing so would have been to more fairly charge or reward the customer

for printing documents and not charge or reward for documents that are sent but not

printed due to error. Gacek and Yeung et al. are combinable because they are from the

same field of communication between elements within a static presentation system. At

the time of the invention, it would have been obvious to a person of ordinary skill in the art to send the amount of data acquired and printed to the server. The motivation for doing so would have been to count only what is printed and not charge or reward customers for documents that are sent but not printed due to error.

Referring to claim 2, Gacek discloses the information providing system as defined by claim 1 wherein said printer prints the information when the information is acquired from said information providing server (S615 in Fig. 6B, col. 15, lines 55-58).

Referring to claim 3, Gacek discloses the information providing system as defined by claim 1 wherein said printer prints the information when the information acquired from said information providing server is updated from the information acquired last (col. 12, lines 61-67). The print job disclosed by Gacek is considered updated information when the print job differs and contains new data then the last print job received.

Referring to claim 8, Gacek discloses the information providing system as defined by claim 1 wherein the communication line is a line connected to the Internet (internet 301, Fig. 3).

Referring to claim 9, see claim 1 as needed. Gacek discloses an information providing method comprising the steps of: (a) storing, by an information provider, information into an information providing server (col. 9, lines 28-32); (b) by a printer of a customer, acquiring the information stored in said information providing server (S601-S604, Fig. 6A), printing the information on a print medium (col. 15, lines 55-58); and (c) paying consideration to the customer by the information provider (col. 13, lines 11-16).

Gacek does not disclose expressly the printer notifying an amount acquired and printed

from the server or basing the calculation off the amount notified by the printer. Yeung et

al. disclose by a printer of a customer, notifying an amount of the printed information to

said information providing server (col. 12, lines 39-56). While the Set Top Box as

disclosed by Yeung et al. is located physically separate from the printer, it would have

been obvious to incorporate the printer into the Set Top Box. The motivation for doing

so would have been to combine the functions of the Set Top Box and printer into one

device that would take up less space and be more functional. The calculation disclosed

by Gacek does not disclose expressly calculating the amount of data indicated by the

printer. It would have been obvious for the calculation to be based on based on the

notified amount of information by the printer instead of the amount sent from the server.

The motivation for doing so would have been to more fairly charge or reward the

customer for printing documents and not charge or reward for documents that are sent

but not printed due to error. Gacek and Yeung et al. are combinable because they are

from the same field of communication between elements within a static presentation

system. At the time of the invention, it would have been obvious to a person of ordinary

skill in the art to send the amount of data acquired and printed to the server. The

motivation for doing so would have been to count only what is printed and not charge or

reward customers for documents that are sent but not printed due to error.

Referring to claim 10, Gacek discloses the information providing method as

defined by claim 9 wherein said information providing server and said printer are

connected via the Internet (internet 301, Fig. 3).

Referring to claim 13, see above claims as needed.   Gacek discloses an

information providing system comprising: an information providing server having means

for storing information to be provided to customers (col. 9, lines 28-32); means for

setting a printer at a customer so as to acquire the information stored in said information

providing server (S601-S604, Fig. 6A), to print the information (col. 15, lines 55-58);

wherein said information providing server comprising means for paying the customer by

an information provider (col. 13, lines 11-16). Gacek does not disclose expressly the

printer notifying an amount acquired and printed from the server or basing the

calculation off the amount notified by the printer. Yeung et al. disclose means to notify

an amount of the printed information to said information providing server (col. 12, lines

39-56). While the Set Top Box as disclosed by Yeung et al. is located physically

separate from the printer, it would have been obvious to incorporate the printer into the

Set Top Box. The motivation for doing so would have been to combine the functions of

the Set Top Box and printer into one device that would take up less space and be more

functional. The calculation disclosed by Gacek does not disclose expressly calculating

the amount of data indicated by the printer. It would have been obvious for the

calculation to include the amount of data acquired and printed as indicated by the

printer instead of the amount sent from the server. The motivation for doing so would

have been to more fairly charge or reward the customer for printing documents and not

charge or reward for documents that are sent but not printed due to error. Gacek and

Yeung et al. are combinable because they are from the same field of communication

between elements within a static presentation system. At the time of the invention, it

would have been obvious to a person of ordinary skill in the art to send the amount of

data acquired and printed to the server. The motivation for doing so would have been

to count only what is printed and not charge or reward customers for documents that

are sent but not printed due to error.

Referring to claim 14, Gacek discloses the information providing system as

defined by claim 13 wherein said information providing server and said printer are

connected via an Internet (internet 301, Fig. 3).

Referring to claim 18, see above claims as needed. Gacek discloses a computer

readable program product for performing an information providing service (col. 22, lines

13-22), the program product comprising the steps of; (a) storing information to be

provided to customers in an information providing server (col. 9, lines 28-32); (b) setting

a printer at a customer so as to acquire the information stored in said information

providing server (S601-S604, Fig. 6A), to print the information (col. 15, lines 55-58); (c)

paying the customer (col. 13, lines 11-16). Gacek does not disclose expressly the

printer notifying an amount acquired and printed from the server or basing the

calculation off the amount notified by the printer. Yeung et al. disclose notifying an

amount of the printed information to said information providing server (col. 12, lines 39-

56). While the Set Top Box as disclosed by Yeung et al. is located physically separate

from the printer, it would have been obvious to incorporate the printer into the Set Top

Box. The motivation for doing so would have been to combine the functions of the Set

Top Box and printer into one device that would take up less space and be more

functional. The calculation disclosed by Gacek does not disclose expressly calculating

the amount of data indicated by the printer. It would have been obvious for the

calculation to include the amount of data acquired and printed as indicated by the

printer instead of the amount sent from the server. The motivation for doing so would

have been to more fairly charge or reward the customer for printing documents and not

charge or reward for documents that are sent but not printed due to error. Gacek and

Yeung et al. are combinable because they are from the same field of communication

between elements within a static presentation system. At the time of the invention, it

would have been obvious to a person of ordinary skill in the art to send the amount of

data acquired and printed to the server. The motivation for doing so would have been

to count only what is printed and not charge or reward customers for documents that

are sent but not printed due to error.

Referring to claim 21, see above claims as needed. Gacek discloses a printer

(printer 324 of Fig. 3) connectable to a user terminal (STB 322 of Fig. 3) which receives

information from an information providing server (3rd party merchant, col. 9, lines 28-32)

via a communication line and sends said information to the printer with a print

instruction (col.15, lines 53-62) and sets a print format for the information (col.8, lines

52-58), and wherein the information providing server can calculate a total of the amount

of information (col. 13, lines 11-16), said printer comprising: means for acquiring the

information delivered from said information providing server, said means for acquiring

the information being connected to said information providing server via the

communication line (STB 322 of Fig. 3, col. 9, lines 49-53); means for printing the

acquired information according to a print instruction received from said user terminal

(col. 15, lines 58-62); and means for notifying an amount of information acquired from

said information providing server and printed (col. 13, lines 11-16). Gacek does not

disclose expressly the printer notifying an amount acquired and printed from the server

or basing the calculation off the amount notified by the printer. Yeung et al. disclose

means for notifying an amount of information acquired from said information providing

server and printed (col. 12, lines 39-56). While the Set Top Box as disclosed by Yeung

et al. is located physically separate from the printer, it would have been obvious to

incorporate the printer into the Set Top Box. The motivation for doing so would have

been to combine the functions of the Set Top Box and printer into one device that would

take up less space and be more functional. The calculation disclosed by Gacek does

not disclose expressly calculating the amount of data indicated by the printer. It would

have been obvious for the calculation to include the amount of data acquired and

printed as indicated by the printer instead of the amount sent from the server. The

motivation for doing so would have been to more fairly charge or reward the customer

for printing documents and not charge or reward for documents that are sent but not

printed due to error. Gacek and Yeung et al. are combinable because they are from the

same field of communication between elements within a static presentation system. At

the time of the invention, it would have been obvious to a person of ordinary skill in the

art to send the amount of data acquired and printed to the server. The motivation for

doing so would have been to count only what is printed and not charge or reward

customers for documents that are sent but not printed due to error.

Referring to claim 22, see above claims as needed. Gacek discloses a printer

(printer 324 of Fig. 3) connectable to a user terminal (STB 322 of Fig. 3) which receives

information from an information providing server (3rd party merchant, col. 9, lines 28-32)

via a communication line and sends said information to the printer with a print

instruction (col.15, lines 58-62) and sets a print format for the information (col.8, lines

52-58), and wherein the information providing server can calculate a total of the amount

of information (col. 13, lines 11-16), said printer comprising: a printhead which prints the

acquired information according to a print instruction received from said user terminal

(col. 15, lines 58-62); and an information processor which acquires information

delivered from said information providing server via the communication line (STB 322 of

Fig. 3, col. 9, lines 49-53), and which provides notification of an amount of information

acquired from said information providing server and printed (col. 13, lines 11-16).

Gacek discloses that the print format of the information is set from the preference

directory within CHE 6. While the method of obtaining the preferences is not given,

Gacek discloses that the user provides these preferences to the CHE 6 (col. 13, lines

46-51), but not how this information is obtained. It would be well known and obvious for

the user to enter this information through the Set Top Box. The suggestion for doing so

would have been to provide an easy way to provide the user preferences without the

requirement of using a phone or mail service. Official Notice is taken that it is well

known and conventional for a printer to include a printhead and a processor (see MPEP

2144.03). A printhead and processor are standard components in common printers and

the printer disclosed by Gacek is a generic printer. The suggestion for using a

printhead is its function for making contact with the paper and applying the ink or toner to the page. The suggestion for using a processor is its function for controlling the operation of the printhead in printing a document. Gacek does not disclose expressly the printer notifying an amount acquired and printed from the server or basing the calculation off the amount notified by the printer. Yeung et al. disclose means for notifying an amount of information acquired from said information providing server and printed (col. 12, lines 39-56). While the Set Top Box as disclosed by Yeung et al. is located physically separate from the printer, it would have been obvious to incorporate the printer into the Set Top Box. The motivation for doing so would have been to combine the functions of the Set Top Box and printer into one device that would take up less space and be more functional. The calculation disclosed by Gacek does not disclose expressly calculating the amount of data indicated by the printer. It would have been obvious for the calculation to include the amount of data acquired and printed as indicated by the printer instead of the amount sent from the server. The motivation for doing so would have been to more fairly charge or reward the customer for printing documents and not charge or reward for documents that are sent but not printed due to error. Gacek and Yeung et al. are combinable because they are from the same field of communication between elements within a static presentation system. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to send the amount of data acquired and printed to the server. The motivation for doing so would have been to count only what is printed and not charge or reward customers for documents that are sent but not printed due to error.

5.   Claims 1, 11, 12, 15-17, 19, and 20 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Kolls U.S. Patent 6,615,183 and Yeung et al. U.S. Patent 6,690,481.

        Referring to claim 1, Kolls discloses an information providing system comprising:

a printer (printer 104 of Fig. 1); a user terminal (system 500, col. 7, lines 6-30)

connected to said printer and sending print information to said printer (block 1408 of Fig.

16, col. 36, lines 34-37); and an information providing server delivering information via a

communication line (universal server, col. 13, lines 19-40), wherein said printer

comprises: means for acquiring the information delivered from said information

providing server, said means for acquiring the information being connected to said

information providing server via the communication line (modem control means 512, col.

41, lines 57-63); means for printing the acquired information according to a print

instruction received from said user terminal (col. 41, lines 24-28), wherein said user

terminal comprises: means for sending a print instruction to said printer (col. 41, lines

24-28); and means for setting a print format of the information, which is acquired from

said information providing server (col. 41, lines 57-63), in said printer, and wherein said

information providing server comprises: means for calculating a total of the amount of

information (block 1504, col. 36, lines 62-66). The coupon data disclosed by Kolls can

include data accessible by system 500 (col. 41, lines 57-63). With modem control

means 512, coupon data can consist of information from the server. Kolls discloses that

printed data can consist of information obtained from PC 630 (col. 35, lines 60-66). By

using a computer, the user can control the print format of the information. Kolls

what is printed and not charge or reward customers for documents that are sent but not

printed due to error.

Referring to claim 11, Kolls discloses an information providing method

comprising the steps of: (a) storing, by an information provider, information into an

information providing server (col. 41, lines 57-63); (b) lending printer from the

information provider to a customer (col. 17, lines 42-55); (c) by said Printer, acquiring

the information stored in said information providing server (block 1408, col. 36, lines 33-

35), printing the information on a print medium (col. 36, lines 46-50); and (d) collecting,

by the information provider, an amount of value corresponding to a rental charge of said

printer from the customer (block 1504, col. 36, lines 62-64). Kolls does not disclose

expressly the printer notifying an amount acquired and printed from the server or basing

the calculation off the amount notified by the printer. Yeung et al. disclose the step of

by said printer, notifying an amount of the printed information to said information

providing server (col. 12, lines 39-56). While the Set Top Box as disclosed by Yeung et

al. is located physically separate from the printer, it would have been obvious to

incorporate the printer into the Set Top Box. The motivation for doing so would have

been to combine the functions of the Set Top Box and printer into one device that would

take up less space and be more functional. The collection disclosed by Kolls does not

disclose expressly being based on the amount of data indicated by the printer. It would

have been obvious for the collection to include the amount of data acquired and printed

as indicated by the printer instead of the amount sent from the server. The motivation

for doing so would have been to more fairly charge or reward the customer for printing

discloses a generic printer and does not disclose expressly the components within the printer. It is well known and conventional for a printer to be physically connected to a computer and a server via a communication line. The suggestion for doing so would have been for the printer to receive the information that it is printing. Kolls does not disclose expressly the printer notifying an amount acquired and printed from the server or basing the calculation off the amount notified by the printer. Yeung et al. disclose the means for notifying an amount of information acquired from said information providing server and printed (col. 12, lines 39-56). While the Set Top Box as disclosed by Yeung et al. is located physically separate from the printer, it would have been obvious to incorporate the printer into the Set Top Box. The motivation for doing so would have been to combine the functions of the Set Top Box and printer into one device that would take up less space and be more functional. The collection disclosed by Kolls does not disclose expressly being based on the amount of data indicated by the printer. It would have been obvious for the collection to include the amount of data acquired and printed as indicated by the printer instead of the amount sent from the server. The motivation for doing so would have been to more fairly charge or reward the customer for printing documents and not charge or reward for documents that are sent but not printed due to error. Kolls and Yeung et al. are combinable because they are from the same field of internet document delivery printing systems. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to send the amount of data acquired and printed to the server. The motivation for doing so would have been to count only

documents and not charge or reward for documents that are sent but not printed due to
error. Kolls and Yeung et al. are combinable because they are from the same field of
internet document delivery printing systems. At the time of the invention, it would have
been obvious to a person of ordinary skill in the art to send the amount of data acquired
and printed to the server. The motivation for doing so would have been to count only
what is printed and not charge or reward customers for documents that are sent but not
printed due to error.

Referring to claim 12, Kolls discloses the information providing method as
defined by claim 11 wherein said information providing server and said printer are
connected via the Internet (col. 6, lines 29-32).

Referring to claim 15, Kolls discloses an information providing system
comprising: an information Providing server having means for storing, by an information
provider, information to be provided to customers (col. 41, lines 57-63); means for
registering a printer lent from the information provider to a customer (col. 17, lines 42-
55); means for setting said printer so as to acquire the information stored in said
information providing server (block 1408, col. 36, lines 33-35), to print the acquired
information (col. 36, lines 46-50); and means for collecting a rental charge of said printer
from the customer (block 1504, col. 36, lines 62-64). Kolls does not disclose expressly
the printer notifying an amount acquired and printed from the server or basing the
calculation off the amount notified by the printer. Yeung et al. disclose means to notify
an amount of the printed information to said information providing server (col. 12, lines
39-56). While the Set Top Box as disclosed by Yeung et al. is located physically

separate from the printer, it would have been obvious to incorporate the printer into the Set Top Box. The motivation for doing so would have been to combine the functions of the Set Top Box and printer into one device that would take up less space and be more functional. The collection disclosed by Kolls does not disclose expressly being based on the amount of data indicated by the printer. It would have been obvious for the collection to include the amount of data acquired and printed as indicated by the printer instead of the amount sent from the server. The motivation for doing so would have been to more fairly charge or reward the customer for printing documents and not charge or reward for documents that are sent but not printed due to error. Kolls and Yeung et al. are combinable because they are from the same field of internet document delivery printing systems. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to send the amount of data acquired and printed to the server. The motivation for doing so would have been to count only what is printed and not charge or reward customers for documents that are sent but not printed due to error.

Referring to claim 16, Kolls discloses the information providing system as defined by claim 15 wherein said information providing server and said printer are connected via an Internet (col. 6, lines 29-32).

Referring to claim 17, Kolls discloses the information providing system as defined by claim 15, wherein said means for setting the printer includes a program which performs said setting through being accessed by said printer (col. 5, lines 2-4).

Referring to claim 19, Kolls discloses a computer readable program product for performing an information providing service (col. 5, lines 2-4), the program product

comprising the steps of; (a) storing information to be provided to customers in an

information providing server (col. 41, lines 57-63); (b) registering a printer lent from an

information provider to a customer (col. 17, lines 42-55); (c) setting said printer so as to

acquire the information stored in said information providing server (block 1408, col. 36,

lines 33-35), to print the acquired information (col. 36, lines 46-50); and (d) collecting an

amount of value corresponding to a rental charge of said printer from the customer

(block 1504, col. 36, lines 62-64). Kolls does not disclose expressly the printer notifying

an amount acquired and printed from the server or basing the calculation off the amount

notified by the printer. Yeung et al. disclose the step of notifying an amount of the

printed information to said information providing server (col. 12, lines 39-56). While the

Set Top Box as disclosed by Yeung et al. is located physically separate from the printer,

it would have been obvious to incorporate the printer into the Set Top Box. The

motivation for doing so would have been to combine the functions of the Set Top Box

and printer into one device that would take up less space and be more functional. The

collection disclosed by Kolls does not disclose expressly being based on the amount of

data indicated by the printer. It would have been obvious for the collection to include

the amount of data acquired and printed as indicated by the printer instead of the

amount sent from the server. The motivation for doing so would have been to more

fairly charge or reward the customer for printing documents and not charge or reward

for documents that are sent but not printed due to error. Kolls and Yeung et al. are

combinable because they are from the same field of internet document delivery printing

systems. At the time of the invention, it would have been obvious to a person of

ordinary skill in the art to send the amount of data acquired and printed to the server.

The motivation for doing so would have been to count only what is printed and not

charge or reward customers for documents that are sent but not printed due to error.

Referring to claim 20, Kolls discloses the program product as defined by claim

19, wherein said amount of value corresponds to a rental charge less an amount

associated with the notified amount of the printer information (col. 40, lines 36-41).

6.   Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kolls U.S.

Patent 6,615,183 and Yeung et al. U.S. Patent 6,690,481, as applied to claim 1 above,

and further in view of Massarsky U.S. Patent 6,718,123.

Kolls discloses the information providing system as defined by claim 1 wherein,

when said printer prints the information received from said user terminal, said printer

prints the information, which is acquired from said information providing server. Kolls

discloses that printed coupon data can consist of financial or other internet based data

(col.41, lines 57-63). Kolls does not expressly disclose printing in the print margin.

Massarsky discloses inserting advertisements onto printed photographs at photo-booths

(col. 6, lines 49- 56). The location of the advertisement is shown as with the print

margin (Fig. 5A). At the time the invention was made, it would have been obvious to a

person of ordinary skill in the art to insert the advertisements into internet based data as

disclosed by Kolls into the print margin as disclosed by Massarsky. One of ordinary skill

in the art would have been motivated to do this to keep the dimensions of the printing

area of the internet based data while allowing an advertisement to be inserted into the

printed material and so as to not interfere with the picture being printed since the margin

is outside the picture image.

7.   Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kolls U.S.

Patent 6,615,183 and Yeung et al. U.S. Patent 6,690,481 as applied to claim 1 above,

and further in view of Massarsky U.S. Patent 6,718,123 and Muramatsu et al. U.S.

Patent 5,818,606.

        Kolls, Massarsky, and Muramatsu et al. disclose the information providing

system as defined by claim 1 wherein, when said printer prints the information received

from said user terminal, said printer prints the information, which is acquired from said

information providing server. Kolls discloses that printed coupon data can consist of

financial or other internet based data (col.41, lines 57-63). Kolls does not expressly

disclose printing in the print margin. Massarsky discloses inserting advertisements onto

printed photographs at photo-booths (col. 6, lines 49- 56). The location of the

advertisement is shown as with the print margin (Fig. 5A). Massarsky does not

expressly disclose reducing the print field of the information to produce a print margin.

Muramatsu et al. discloses a printing method of reducing the size of printing material

(Fig. 29, col. 22, lines 42-44). At the time the invention was made, it would have been

obvious to a person of ordinary skill in the art to produce a print margin with the printing

method disclosed by Muramatsu, insert an advertisement into printed material as

disclosed by Massarsky, and combine coupons with internet based data as disclosed by

Kolls. One of ordinary skill in the art would have been motivated to do this to allow a

greater area for coupons to be inserted into printed internet based data and to make the

items being printed better fit into the document without interfering with the picture being

printed.

8.   Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kolls U.S.

Patent 6,615,183 and Yeung et al. U.S. Patent 6,690,481 as applied to claim 1 above,

and further in view of Freedman U.S. Patent 4,839,829.

        Kolls discloses the information providing system as defined by claim 1 wherein,

when said printer prints the information received from said user terminal, said printer

combines the information acquired from said information providing server. Kolls

discloses that printed coupon data can consist of financial or other internet based data

(col.41, lines 57-63). Kolls does not expressly disclose printing in blank portions of the

document. Freedman discloses inserting advertisements into blank portions of printed

material (col. 10, lines 11-14). At the time the invention was made, it would have been

obvious to a person of ordinary skill in the art to insert the advertisements into internet

based data as disclosed by Kolls into blank portions of printed material as disclosed by

Freedman. One of ordinary skill in the art would have been motivated to do this to

efficiently allow coupons to be inserted into printed internet based data without wasting

paper space.

9.   Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kolls U.S.

Patent 6,615,183 and Yeung et al. U.S. Patent 6,690,481 as applied to claim 1 above,

and further in view of DeBruin-Ashton U.S. Patent 6,014,629.

DeBruin-Ashton discloses the information providing system as defined by claim 1

wherein said printer prints the information, which is acquired from said information

providing server. Kolls discloses that printed coupon data can consist of financial or

other internet based data (col.41, lines 57-63). Kolls does not expressly disclose

printing on the reverse side of the document. DeBruin-Ashton discloses inserting

advertisements onto the other side of printed material (Fig. 3A and Fig. 3B, col. 13, lines

48-53). At the time the invention was made, it would have been obvious to a person of

ordinary skill in the art to insert the advertisements into internet based data as disclosed

by Kolls onto both sides of printed material as disclosed by DeBruin-Ashton. One of

ordinary skill in the art would have been motivated to do this to allow utilizing both sides

of a page and eliminate wasted paper space for inserting coupons onto printed internet

based data.

Conclusion

10.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time
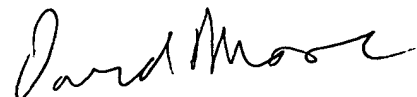
policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Peter K. Huntsinger whose telephone number is

(571)272-7435. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, David Moore can be reached on (571)272-7437. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

PKH

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